

U.S. Serial No.: 10/786,773
Response to Office Action dated 02/23/2005

REMARKS/ARGUMENTS

Claims 1-20 were pending in the application since filing. Claim 8 is canceled and new claim 21 is added. Also, claims 9, 11, and 15 are withdrawn from consideration, and claims 19 and 20 are canceled, in order to comply with a requirement to elect a species for initial prosecution on the merits.

Entry of claim 21 is respectfully requested. Upon entry of claim 21 and withdrawal or cancellation of claims 9, 11, 15, 19 and 20, claims 1-7, 10, 12-14, 16-18, and 21 are pending and under present consideration.

It is noted that Applicant considers that claim 21 is generic to all alleged species identified in that Office action except the species of Figures 7A, 7B. This is believed to be the case albeit a weight limitation is found in claim 21.

Also, it is noted that claim 13 comprises two amendments herein. One amendment is made to overcome a rejection under 35 USC 112, second paragraph (see below). The other amendment is made to better clarify the claim, and is not made in response to any patentability-based rejection. This latter amendment amends the phrase "walking for a period of at least/between 20 and 60 minutes . . ." to "walking for a period between 20 and 60 minutes . . .". Entry of both such amendments to claim 13 is respectfully requested.

Affirmation of Provisional (Telephonic) Election

To comply with the restriction requirement, Applicant herewith affirms election of a single disclosed species for prosecution on the merits. Applicant hereby identifies the elected disclosed species as the invention of Figure 1A-1F, and lists the claims

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readable thereon as claims 1-8, 10, 12-14, 16-18, and 21. This confirms the telephonic election of January 18, 2005, made during a telephone call between the Examiner and attorney for Applicant, Mr. Joseph Fischer. To comply with this election, Applicant herewith withdraws from present consideration claims 9, 11, and 15, and cancels claims 19 and 20.

However, this election and affirmation should not be taken to indicate agreement with the manner in which non-elected claims were restricted into groups. Applicant respectfully traverses this species restriction/election requirement for the following reasons.

Applicant points out that requiring the restriction of claims is discretionary, and urges that examination of all the claims as filed would not require additional searching, nor place any undue burden on the Patent Office. As MPEP 803 states, both of the following criteria are required for a proper restriction requirement:

- A) the inventions are independent or distinct as claimed, and
- B) "There must be a serious burden on the examiner if restriction is required . . .".

Given the nature and number of the claims, it does not appear that a serious burden exists, even if the inventions are considered independent or distinct. Accordingly, at to traverse, reconsideration of the nature and extent of the restriction requirement is respectfully requested.

Also, page 2 of the Office action states, "Currently, claims 13 and 16-18 are generic." Applicant respectfully opines that claim 10 also is generic, as to all alleged species identified in that Office action except the species of Figures 7A, 7B. This is believed to be the case albeit a weight limitation is found in claim 10. As noted above, Applicant also considers new claim 21 to be generic to all alleged species identified in that Office

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action except the species of Figures 7A, 7B, and considering that a weight limitation is found in claim 21.

Claim Rejection(s) under 35 U.S.C. § 112

Claims 1-4, 8, 10, 12-14 and 16-18 stand rejected under 35 U.S.C. § 112, second paragraph.

As to the use of the term "conventional" in claims 1, 8, 10, 12, 13, and 16, the Office action states "the scope of the term "conventional" cannot be determined." First, Applicant asserts that a *prima facie* case of indefiniteness has not been established because, by this statement alone, the Patent Office has not met its initial burden of showing that the claim language is indefinite to one of skill in the art. That is, there is no reasoning as to why one skilled in the art would not understand the scope of the claim when it contains the term "conventional" before "headwear."

Second, even assuming *arguendo* that a *prima facie* case of indefiniteness were established, Applicant respectfully points out that the scope of the term "conventional" can be and is determined by reference to paragraph 0041 of the application, reproduced here:

The above listed hats and caps, and the above listed generic styles, fall within the scope of "conventional headwear," this term comprising "conventional hats" (also, "conventional-styled hats") and "conventional caps" (also, "conventional-styled caps"). Conventional headwear is contrasted with specifically styled exercise helmets, athletic protective helmets, industrial helmets, and other devices that are conspicuous when worn during everyday activities and outside their normal scope of use. When a weight-adding component of the present invention is part of, added to, or attached below, any of those conventional hats and caps, such hat or cap is headwear of the present invention.

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By the nature of the plain language of this and preceding paragraphs 0039 and 0040, one of skill in the art studying these claims would understand that conventional headwear includes those hats and caps having styles that one would find in everyday use, and would exclude "specifically styled exercise helmets, athletic protective helmets, industrial helmets, and other devices that are conspicuous when worn during everyday activities and outside their normal scope of use." Also, specific examples of styles that fall within the scope of the term "conventional headwear" are provided. This, additionally, is instructive as to the scope of the term. It is well-established that claims are definite under 35 USC 112, second paragraph, if the claims, read in light of the specification, *reasonably apprise* those skilled in the art of the scope and use of the invention, and if the language is as precise as the particular subject matter permits. Applicant respectfully asserts that in the claims the term "conventional" before "headwear" reasonably apprises those skilled in the art of the scope and use of the invention. That is, one skilled in the art would understand the scope of a claim that includes the term "conventional headwear" when the claim is read in light of the specification.

Accordingly, considering that a prima facie case of indefiniteness has not been made, Applicant respectfully requests withdrawal of this basis of rejection. In the alternative, in view of the second argument, above, reconsideration and withdrawal of this basis of rejection is respectfully requested.

As to claim 8, the Office action additionally states that claim 8 "is confusing as to how the skullcap may "comprise" the hat or cap and the hat or cap may "receive" the skullcap as an inner compartment." Applicant acknowledges the structural difficulty of claim 8, and herein cancels claim 8. New independent claim 21 comprises elements of claim 8 in a format believed acceptable with regard to the basis of rejection of claim 8.

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The scope of claim 21 is not narrower than the scope of claim 8, and no new matter is added.

As to claim 13, the Office action additionally states that in claim 13 "'said hat" line 7 has no antecedent basis." Applicant herein amends claim 13 to address this basis for rejection. Reconsideration and withdrawal of this basis of rejection is respectfully requested.

Claim Rejection(s) under 35 U.S.C. § 103

Claims 1-8, 10 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Niv, U.S. 6,110,080, in view of Gruget, U.S. 3,342,036. Reconsideration and withdrawal of this basis for rejection is respectfully requested for the following reasons.

First, Applicant believes that a *prima facie* case of obviousness has not been met because neither the Niv '080 reference nor the Gruget '036 reference provides some teaching or motivation to combine these references to obtain the invention as claimed in claims 1-8, 10 and 12. The Office action simply states "It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the weighted layers comprising an elastomer and weighted bodies of Gruget for the weighted layers as at 26, 30 of Niv to achieve the advantage of employing weighted layers capable of conforming to body contours as taught by Gruget." The Office action appears conclusory on this point, and fails to articulate a reasonable explanation that leads one to find a teaching or motivation to combine these disparate references to achieve the respective combination of elements in claims 1-8, 10 and 12. Accordingly, neither the patents cited in the Office action, nor any other evidence of record, establish a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests withdrawal of this rejection.

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Second, even assuming *arguendo* that a *prima facie* case of obviousness were established, features of the Niv reference differ substantially from the claimed invention, and thus are not amenable to the combination as stated in the Office action. As to the Office action discussion of claims 1, 3, 5 and 6, Niv describes '26' as 'tubular weights' (col. 4, line 14), not 'weighted layer' as stated in the Office action on page 4. Niv at col. 4, lines 20-24, describes '30' simply as a weight, which is stated to fit into a pocket 28. No evidence has been provided to demonstrate that these weights are a 'weighted layer,' and the evidence strongly indicates that these are discrete weights unrelated to a weighted layer. Further, it is clear that Niv teaches a particular approach to adding discrete weights to a therapeutic (i.e., not conventional) headpiece, and that both the use of discrete weights, placed in visible external pockets and sleeves, and the use of a therapeutic headpiece, teach away from the present invention. Accordingly, this reference is not appropriate to use in rejection of these claims.

As to the Office action discussion of claims 2, 4, 7 and 12, the above arguments regarding claim 1 apply to claims 2, 4 and 7, which depend from claim 1. Also as to the Office action discussion of claim 4, the thickness is relevant to an elastomeric layer that fits within a conventional headwear, such as to achieve the weighted headwear of claim 10, so that claim 4 may be viewed to define a suitable subcomponent. In that neither Niv nor Gruget teach an elastomeric weighted layer dimensioned to fit under or into conventional headwear, and having a thickness amenable to placement under such conventional headwear, and in that there is no teaching or suggestion to combine these references, combining these references for this and other rejections arguably involves impermissible hindsight. Also as to the Office action discussion of claim 7, Applicant respectfully asserts that the combination of a discrete tubular weight 26 in a sleeve 22 does not comprise a 'weighted layer,' nor an elastomeric weighted layer, and additionally does not meet other limitations of claim 1 or claim 7. Accordingly, *inter alia*, the basis for this rejection is disputed based on the clear structural differences between

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the present invention and Niv, even in view of Gruget, based on plain meaning of the terms and the present specification.

As to claim 8, the weighted therapeutic headpiece defined by 12, 26 and 30 of Niv clearly is not a conventional style hat or cap additionally meeting other limitations of claim 5 and 8. This distinction also applies to new claim 21.

Applicant does not understand the reasoning for the rejection of claim 12 at the bottom of page 12; no reference to features of Niv or Gruget is provided as to this rejection. However, as to this claim, as noted above the above arguments apply with regard to claim 1 from which claim 2 depends.

Finally, *inter alia* as to claims 10 and 12, even combining the references does not teach the present invention, as the cited references do not teach a weighted elastomeric layer in conventional headwear.

Claims 13 and 16-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Niv, U.S. 6,110,080, in view of Kuss, U.S. 2,357,746. Reconsideration and withdrawal of this basis for rejection is respectfully requested for the following reasons.

First, Applicant believes that a *prima facie* case of obviousness has not been met because neither the Niv '080 reference nor the Kuss '746 reference provides some teaching or motivation to combine these references to obtain the invention as claimed in claims 13 and 16-18. The Office action simply states "It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Niv such that the headwear is worn while walking in view of such teaching by Kuss to achieve the advantage of improving posture." The Office action appears conclusory on this point, and fails to articulate a reasonable, logical explanation that leads one to find a teaching

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or motivation to combine these references to achieve the respective combination of elements in claims 13 and 16-18. Accordingly, neither the patents cited in the Office action, nor any other evidence of record, establish a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Further as to this rejection of claims 13 and 16-18, even if the Niv and Kuss references were combined, these do not teach all limitations of these claims. For example, Niv and Kuss teach external weights, whereas claims 13 and 16-18 teach "... positioning on said person's head a conventionally-shaped headwear comprising an added mass, wherein such added mass is within the space within said headwear so positioned ...".

Claims 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Niv, in view of Kuss as applied to claim 13, and further in view of Gruget. Reconsideration and withdrawal of this basis for rejection is respectfully requested for the following reasons.

First, Applicant believes that a *prima facie* case of obviousness has not been met because neither the Niv '080 reference nor the Kuss '746 reference nor the Gruget '036 provides some teaching or motivation to combine these references to obtain the invention as claimed in claim 14. The Office action simply states "It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the weighted layers comprising an elastomer and weighted bodies of Gruget for the weighted layers as at 26, 30, of Niv to achieve the advantage of employing weighted layers capable of conforming to body contours as taught by Gruget ...". The Office action appears conclusory on this point, and fails to articulate a reasonable, logical explanation that leads one to find a teaching or motivation to combine these references to achieve the respective combination of elements in claim 14 as that claim depends on claim 13. Accordingly, neither the patents cited in the Office action, nor any other

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evidence of record, establish a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Further, as to the characterization of features 26 and 30 as weighted layers, and regarding 22 and 28 of Niv, the above discussion for claims 1-8, 10 and 12 applies to this aspect of the rejection of claim 14.

Particularly, this reference is not reasonably pertinent to the solution to the presently identified problem, that solution being directed to unobtrusively strengthening a person's vertical load-bearing vertebral elements by positioning a conventionally-shaped headwear device on that person's head (having the limitations as stated in claims 13 and 14), and walking for the indicated period of time. *Inter alia*, the therapeutic headwear of Niv, even in view of Gruget, does not provide for such method because it does not teach an unobtrusive weighted headwear.

Allowance of the claims provided herein is respectfully requested. Upon allowance of a relevant generic claim, consideration of each corresponding withdrawn claim is respectfully requested. The Examiner is invited to call the undersigned if clarification is needed on any aspects of this Amendment/Response, or if the Examiner believes a telephonic interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,


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